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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,085	03/10/2000	Douglas S. Foote	9137.00	5683

7590 12/16/2003

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EXAMINER

PWU, JEFFREY C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,085

Applicant(s)

FOOTE ET AL.

Examiner

Jeffrey Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Abstract

1. A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 and 15-29 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the disclosure that the applicant does not describe both the “identifying” and “modifying” steps to satisfy the enablement standard for each aspect of the invention.

See *In re Naquin*, 398 F.2d 863, 866, 158 USPQ 317, 319 CCPA 1968)

Applicant’s specification must enable a person skilled in the art to make and use the claimed invention without undue experimentation. The fact that experimentation is complex, however, will not make it undue if a person of skill in the art typically engages in such complex experimentation. For a computer-related invention, the disclosure must enable a skilled artisan to configure the computer to possess the requisite functionality,

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and, where applicable, interrelate the computer with other elements to yield the claimed invention, without the exercise of undue experimentation. The specification should disclose how to configure or retrofit or modify an ATM or SST to possess the requisite functionality or how to integrate the programmed computer with other elements of the invention, unless a skilled artisan would know how to do so without such disclosure. See, e.g., Dossel, 115 F.3d at 946-47, 42 USPQ2d at 1884-85; Northern Telecom v. Datapoint Corp., 908 F.2d 931, 941-43, 15 USPQ2d 1321, 1328-30 (Fed. Cir.1990)

4. Claims 1-8 and 15-29 are also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed invention is not supported by either specific and substantial asserted utility for the reasons set forth above, one skilled in the art clearly would not know to use the claimed invention. Particularly in the identifying step, modifying step, and/or retrofitting step(s).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-8 and 15-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Claim 1, for example, it is unclear what is applicant's invention, is it identifying an ATM... or modifying an ATM... to receive wireless retrofit.

Applicant's claims must set out and circumscribe the invention with a reasonable degree of precision and particularity. Applicant's claims, interpreted in light of the disclosure, must reasonably apprise a person of ordinary skill in the art of the invention. *In re Dossel*, 115 F.3d 942, 946, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997).

7. Claims 1-8 and 15-29 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is vague and indefinite and unclear of the terms "modifying" and "retrofitting".

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claim 1-8 and 15-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suer et al. (US 6,431,439) in view of Terranova et al. (US 2001/0045457).

10. Claims 1-8 and 15-29 are rejected under 35 U.S.C. 103(a) as being unpatentable by

Suer teaches a method and an apparatus comprising:

➤identifying an ATM (SST) which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash (col.3, line 54-col.4, line 43; 63-fig.2A; col.13, lines 17-40);

➤ wherein said transceiver is further adapted to transmit signals directly to said wireless telephone (col.4, lines 8-65).

wherein said signals implement local wireless communication (col.13, lines 17-col.4, line 17);

➤wherein said ATM is connected to a network for communication therebetween, and wherein said modifying step includes providing a connection between said network and said wireless device (col.13, lines 17-col.4, line 17);

➤wherein said modifying step includes retrofitting the ATM with a transceiver adapted to receive signals directly from the wireless telephone (fig.6, steps 161-162);

➤wherein the transceiver is connectable to a system bus of a computer within the ATM (col.4, lines 30-42);

➤a self-service terminal having been retrofitted to allow the terminal to execute transactions entered using a wireless telephone, wherein said terminal did not allow

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transactions to be entered using a wireless telephone prior to retrofitting (abstract; col.1, lines 13-15; col.3, lines 9-16, 41-50, 55-67, col.4, lines 8-15, 30-53, and col.13, lines 20-23);and

➤ a self-service terminal having been retrofitted to receive a transaction from an authorized source external to the terminal,wherein said terminal did not allow transactions to be entered using a wireless telephone prior to retrofitting (abstract; col.1, lines 13-15; col.3, lines 9-16, 41-50, 55-67, col.4, lines 8-15, 30-53, and col.13, lines 20-23).

However, Suer fails to show a wireless phone to withdraw cash from an ATM.

It is well know in the art to retrofit any controllable electronic device with a wireless transponder/receiver to control the device.

Terranova is applied for showing that is is well know in art to use wireless technology, e.g. cell phones, palm pilots, & etc. to control a fule pump/banking system by modifying an existing electonic controls with wireless communications between a dispenser or associated communications system and a remote communication unit or transponder carried by a person or mounted to a vehicle to control the system.

It would have been obvious to a person having skill in the art at the time of the invention to equip an ATM that dose not have the remote control communication system by using Suer's device to communicate via a transponder/receiver as taught by Terranova to conduct business wirelessly.

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Response to Arguments

12. Applicant's arguments with respect to claims 1-8 and 15-29 have been considered but are moot in view of the new ground(s) of rejection.

☞ Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey Pwu whose telephone number is (703) 308-7835



14 December 2003

**JEFFREY PWU
PRIMARY EXAMINER**